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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,714	02/06/2001	Gary M. Katz	PIP-69A-KATZ	2896
31518	7590	11/18/2008		
NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304			EXAMINER ALVAREZ, RAQUEL	
			ART UNIT 3688	PAPER NUMBER
			NOTIFICATION DATE 11/18/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/776,714

Applicant(s)

KATZ, GARY M.

Examiner

Raquel Alvarez

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/10/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- 7) ☐ Paper No(s)/Mail Date: _____

DETAILED ACTION

1. This office action is in response to 9/10/2008 petition decision.
2. Claims 1-65 are presented for examination.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Based on Supreme Court precedent ¹ and recent Federal Circuit decisions, a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. ² If either of these requirements is met by the claim, the method is non a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

Claims 1 and 28 are rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The applicant is reciting only method steps such as "reciving....identifying...determining", the applicant has not recited an apparatus or device to perform these limitations and without apparatus or device these limitations are just mental steps. Mentioning computer in the preamble is not enough, if the body of the claims each of the steps can be performed manually.

In claims 1 and 28 the steps are related to a mental process, which is not patentable. Indeed, it is not tied to another statutory class or does not change or switch

statutory class (such as a particular apparatus or physical module or device) or does not transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category*.

Examiner suggests applicant inserts a device in one or more steps of the body of the claims in order to overcome this rejection.

¹ Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

² The supreme court recognized that this test is not necessary fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63,71 (1972)

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-5, 7, 9-21, 23-36, 39-42 and 44-46, 62-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Swix et al. (6,718,551 hereinafter Swix).

With respect to claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, 62-65 Swiss teaches a computer implemented method (Abstract). Receiving identification information from a consumer (Figure 2, 210); identifying, based upon said received identification information, one or more parameters related to promotions received by

said consumer (Figure 3, 302); determining a time at which promotions is to be provided based upon said identified one or more parameters related to promotions received by said consumer (col. 10, lines 52 to col. 11, lines 1-3).

With respect to claims 4 5, Swix further teaches that one or more parameters related to said promotions received by said consumer relate to a product class/product industry of said promotions received by said consumer (Figure 3).

With respect to claim 16, Swix further teaches selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said determine d time being for said targeted promotion (col. 12, lines 22-90).

With respect to claims 17-18, Swix further teaches selecting said targeted promotion comprises matching said one or more characteristics of said consumer to a desired consumer profile (col. 12, lines 22-60).

With respect to claims 26 and 44, Swix further teaches determining said time at which said promotion is to be provided comprises determining at least one of a demographic and a purchase characteristic of said consumer (col. 12, lines 22-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 22, 38, 47-61 rejected under 35 U.S.C. 103(a) as being unpatentable over Swix.

Claim 6, 22, 38 further recites that the promotions received by said consumer relate to a location where the promotions can be exercised by the consumer. Official notice is taken that it is old and well known for promotions to have a location in which it can be redeemed in order to promote patronage of an establishment. It would have been obvious a person of ordinary skill in the art at the time of Applicant's invention to have included the promotions received by said consumer relate to a location where the promotions can be exercised by the consumer in order to obtain the above mentioned advantage.

Claims 8 and 37 further recites a promotion validity date. Official notice is taken that it is old and well known for offers to have a validity date in which the offers can be redeemed in order allow promoters/manufacture to better manage the offers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included recites a promotion validity date in order to obtain the above mentioned advantage.

Claim 43 further recites that the promotions have a time of receipt record. Official notice is taken that it is old and well known in the computer related arts to time stamp information received in order to keep track of when the information was received. It would have been obvious to a person of ordinary skill in the art at the time Applicant's invention to have included promotions time receipt record in order to obtain the above mentioned advantage.

Claims 47-58 recite well known forms and methods of distributing offers and would therefore have been obvious to one of ordinary skill in the art to use such a known form of advertisement.

With respect to claims 59-61 Swix teaches a computer implemented method (Abstract). Receiving identification information from a consumer (Figure 2, 210); identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer (Figure 3, 302); determining a time at which promotions is to be provided based upon said identified one or more parameters related to promotions received by said consumer (col. 10, lines 52 to col. 11, lines 1-3). Swix doesn't specifically teach that the receiver is at a vendor location site at a check-out counter in a store. Official Notice is taken that it is old and well known for consumers to identify themselves at the checkout counter at a vendor location site in order to receive promotions/offers based on their current purchases. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the receiver being located at a vendor location site at a check-out counter in a store in order to achieve the above mentioned advantage.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James w. Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
11/10/2008